



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/683,675

10/16/2003

Byung-youn Song

1793.1044

3461

21171

7590

06/30/2006

STAAS & HALSEY LLP

JIM LIVINGSTON

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

WATKO, JULIE ANNE

ART UNIT

PAPER NUMBER

2627

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/683,675

Applicant(s)

SONG ET AL.

Examiner

Julie Anne Watko

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 and 24 is/are allowed.
- 6) ☒ Claim(s) 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/12/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/12/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on June 12, 2006. These drawings are acceptable.

Claim Rejections - 35 USC § 112

2. Applicant has overcome the indefiniteness rejections by amendment.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Matsui (US Pat. No. 5734638).

As recited in claim 23, Applicant's admitted prior art shows an optical pickup actuator (see Applicant's Fig. 1) for an objective lens 42, comprising: a base 12; a wire holder 14 installed to the base; a bobbin 40 holding the objective lens; a first yoke 20' positioned between a first side of the bobbin and the wire holder; a second yoke 20 positioned opposing a second side of the bobbin, a plurality of suspension wires 44a-b each having one end fixed to the wire holder and an other end movably supporting the bobbin, and a magnetic driving unit (including coils and magnets) driving the bobbin in focusing and tracking directions.

As recited in claim 23, Applicant's admitted prior art is silent regarding a damping member insertable into an opening in the first yoke, wherein a groove is formed in the damping member, and one of the suspension wires is movably inserted into the groove.

Art Unit: 2627

Matsui shows a damping box 18 rigidly attached to a yoke 26 (see Fig. 2A, for example), wherein the silicone gel and silicone rubber (see Figs. 5A-5B) are damping members with suspension wires movably inserted into their grooves.

There is no invention in making one-piece integral that which was already known to be plural members rigidly attached, absent a showing that the integration involved greater than ordinary skill in the art in combination with unexpected results due to the claimed integration. *In re Fridolph* 135 USPQ 319 (CCPA 1962). Moreover, use of one piece construction instead of attached multipart structure is a matter of obvious engineering choice. *In re Larson*, 144 USPQ 347 (CCPA 1965).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the damping box with the bent metal plate yoke of Matsui such that the hole in the damping box is a hole in the yoke, so that the silicone gel and silicone rubber are damping members with suspension wires movably inserted into their grooves. The rationale is as follows: one of ordinary skill in the art would have been motivated to arrive at the claimed integration as a matter of obvious engineering choice in order to reduce costs by decreasing a number of assembly steps as is notoriously well known in the art.

Allowable Subject Matter

5. Claims 9 and 24 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter:
See Applicant's arguments filed June 12, 2006, which are persuasive.

Response to Arguments

7. Applicant's arguments filed June 12, 2006, have been fully considered but they are not persuasive.

On page 7, 2nd to last paragraph, Applicant argues that “APA and Matsui, taken separately or in combination, do not disclose, teach, or suggest at least, “a groove formed in the damping member, and one of the suspension wires is movably inserted into the groove,” as recited in claim 23.”

The Examiner has considered this argument thoroughly and asserts that Matsui clearly shows silicone (33 and/or 34) with a groove, and wire 31 movably inserted into the groove (see Figs. 5A-5B). The silicone is a damping member. Movement of the wire causes “shear stress” (see col. 5, line 4, “damping effect can be achieved by the shear stress”) which causes damping. There is no invention in making the damping box 18 integral with the yoke. When the damping box is made part of the yoke, the silicone remains a damping member with a groove and a wire movably inserted into the groove.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2627

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on Monday through Thursday, noon to 10PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko, J.D.
Primary Examiner
Art Unit 2627

June 25, 2006
JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', with a stylized flourish at the end.